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REMARKS

Claims 1-5, 8-12, 16-20, 22-24, 26 and 27 are currently pending in the subject application and are presently under consideration. Claims 1-3, 5, 8, 10-12, 16 and 26 have been amended to cure minor informalities as shown on pp. 2-5 of the Reply. In addition, it should be noted that a Supplemental Preliminary Amendment was filed February 23, 2005 to replace the Cross-Reference To Related Applications section to which the Examiner requires correction in the current Office Action.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 1-5, 8-12, 16-20, 22-24, 26 and 27 Under 35 U.S.C. §101**

Claims 1-5, 8-12, 16-20, 22-24, 26 and 27 stand rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. This rejection should be withdrawn for at least the following reasons. Independent claims 1 and 16 have been amended to overcome the Examiner's concerns and it is believed that these amendments place the subject claims in better condition for allowance. Further, applicants' representative disagrees with the Examiner's characterization with respect to independent claim 27.

With respect to independent claim 27, which recites: *a computer readable medium storing computer executable instructions for a method for parsing XML*, the Examiner asserts that since the specification at page 26, line 25-page 27, line 4 defines "computer readable medium" as including intangible media such as carrier waves incapable of being touched or perceived absent of the tangible medium through which they are conveyed, the subject claim is non-statutory because the claimed "medium" is not limited to tangible media. Applicants' representative avers to the contrary.

According to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the legal standard set forth by the Federal circuit for determining whether claims are directed towards statutory subject matter is whether the claims can be applied in a practical application to produce a useful, concrete and tangible result. In *AT&T*, the patent at issue described a message record for long-distance telephone calls that included a primary interexchange carrier ("PIC") indicator, which allowed for differential billing

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treatment for subscribers. (See *AT&T*, 172 F.3d at 1353). AT&T's claimed process applied Boolean algebra "to determine the value of the PIC indicator, and [applied] that value through switching and recording mechanisms to create a signal useful for billing purposes." (See *AT&T*, 172 F.3d at 1358). Relying on its holdings in *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), *cert. denied*, 525 US 1093 (1999) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053 (Fed. Cir. 1992), the Court held that the AT&T process was patentable subject matter:

In *State Street*, we held that the processing system there was patentable subject matter because the system takes data representing discrete dollar amounts through a series of mathematical calculations to determine a final share price – *a useful, concrete, and tangible result*. See 149 F.3d at 1373, 47 USPQ2d at 1601. In this case, Excel argues, correctly, that the PIC indicator value is derived using a simple mathematical principle (p and q). But that is not determinative because AT&T does not claim the Boolean principle as such or attempt to forestall its use in any other application. It is clear from the written description of the '184 patent that AT&T is only claiming a process that uses the Boolean principle in order to determine the value of the PIC indicator. The PIC indicator represents *information* about the call recipient's PIC, *a useful, non-abstract result* that facilitates differential billing of long-distance calls made by an IXC's subscriber. Because the claimed process applies the Boolean principle to produce a *useful, concrete, tangible result* without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of Section 101. See *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1060, 22 USPQ2d 1033, 1039 (Fed. Cir. 1992) ("That the product is numerical is not a criterion of whether the claim is directed to statutory subject matter."). See *AT&T*, 172 F.3d at 1358 (emphasis added)..

In *Arrhythmia*, electrocardiograph signals were input into a computer and filtered and analyzed to determine the average magnitude of the signals. The resulting output signal was then compared to a predetermined level to determine whether the patient was at high risk for a particular arrhythmia. The Court found the claims patentable subject matter stating:

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The resultant output is not an abstract number, but is a *signal* related to the patient's heart activity. These claimed steps of "converting", "applying", "determining", and "comparing" are physical process steps that transform one *physical, electrical signal* into another. *The view that "there is nothing necessarily physical about 'signals' " is incorrect. In re Taner*, 681 F.2d 787, 790, 214 USPQ 678, 681 (CCPA 1982) (holding statutory claims to a method of seismic exploration including the mathematically described steps of "summing" and "simulating from"). . . . The computer-performed operations transform a particular input *signal* to a different output *signal*, in accordance with the internal structure of the computer as configured by electronic instructions. "The claimed invention . . . converts one *physical thing* into another *physical thing* just as any other electrical circuitry would do". *Arrhythmia*, 958 F.2d at 1059, 1060 (citations omitted) (emphasis added).

In *State Street*, the Federal Circuit remarked upon its decision in *Arrhythmia* and noted that the transformation of electrocardiographic signals was patentable as "a practical application of an abstract idea . . . because it corresponded to a useful, concrete or tangible thing – the condition of a patient's heart." (*State Street*, 149 F.3d at 1373). The Federal Circuit also remarked in *State Street* that:

We note that, for the purposes of a Section 101 analysis, it is of little relevance whether [a claim] is directed to a "machine" or a "process," as long as it falls within at least one of the four enumerated categories of patentable subject matter . . . . *State Street*, 149, F.3d at 1373.

As noted *supra*, the Federal Circuit case law supports that carrier waves/signals fall within at least one of the four enumerated categories of patentable subject matter. The Federal Circuit has made clear that signals are physical things, (*See Arrhythmia*, 958 F.2d at 1059, 1060), and as such carrier signals/waves are not naturally occurring phenomena, but rather, manufactured signals which accordingly are patentable products of manufacture in and of themselves. Thus, as discussed in the specification communication media such as carrier waves/signals are physical things and are useful and fall within the ambit of being classified as computer readable media. Consequently,

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the subject claim clearly meets the aforementioned legal standards set forth in *AT&T Corp. v. Excel Communications, Inc.*, *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*

Further, it is submitted that even if carrier waves or signals were not patentable subject matter (which for reasons stated *supra* would be contrary to current case law), it is apparent that the claimed computer-readable medium is not defined in the specification as being specifically a carrier wave or signal. Rather, the specification clearly indicates that the computer-readable medium can *comprise* a carrier wave or signal, which is clearly distinguishable from the computer-readable medium *being* a carrier wave or signal. Thus, given this clarification, it is apparent that there exists a requisite functional interrelationship between the computer-readable medium and the carrier wave or signal (e.g., the waveform causes a concrete alteration to portions of the computer-readable medium). Accordingly, this rejection should be withdrawn with respect to independent claims 1, 16 and 27, and claims that depend there from.

## **II. Objection to Claims 8 and 11-12**

Claims 8 and 11-12 are objected to for minor informalities. These objections are now believed to be moot in view of the amendments made herein to the subject claims. Accordingly, reversal of the objection to claims 8 and 11-12 is respectfully requested.

## **III. Rejection of Claim 26 Under 35 U.S.C. §112**

Claim 26 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Reversal of this rejection is requested for at least the following reasons. Claim 26 has been amended herein to cure the informality identified by the Examiner. Accordingly, withdrawal of this rejection is requested.

## **IV. Rejection of Claims 1-5, 8, 10-12, 16-20, 22-24, 26 and 27 Under 35 U.S.C. §102(e)**

Claims 1-5, 8, 10-12, 16-20, 22-24, 26 and 27 stand rejected under 35 U.S.C. §102(e) as being anticipated by Cseri *et al.* (US 2003/0046317). This rejection should be

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withdrawn for at least the following reasons. Cseri *et al.* does not disclose or suggest each and every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim.* *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaa Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Applicants' claimed invention relates to a configurable, object-oriented pull model XML parser that exposes an interface that facilitates abstracting input sources. In particular, independent claim 1 recites: *a reader that selectively pulls the XML item from the XML stream.* Similarly, independent claims 16 and 27 recite: *selectively pulling an XML item based, at least in part, on the parse request.* Cseri *et al.* does not disclose or suggest such novel aspects of applicants' claimed invention.

Cseri *et al.* discloses a technique for incorporating binary formatting into a tag-based description language, such as XML, wherein the binary formatting is achieved by tokenizing the tag and attribute names into variable sized numeric tokens, thus obviating the need for repetitive or redundant storage of lengthy Unicode words. Such binary formatting, according to the cited document, minimizes parsing time and the generation of overhead incident to the formatting and parsing of data. The Office Action asserts that Cseri *et al.* provides for the selective pulling of an XML item from the XML stream at page 1, para. [0004]-[0006]. Applicants' representative avers to the contrary and asserts that Cseri *et al.*, while admittedly enumerating the current problems associated with parsing XML, does not elucidate the pull model XML parser recited in the subject claims, and in particular, a pull model XML parser that selectively pulls XML items from a XML stream. In fact, nowhere in Cseri *et al.* is this exemplary feature disclosed let alone suggested. Accordingly, withdrawal of this rejection with respect to independent claims 1, 16 and 27, and associated dependent claims, is respectfully requested.

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**V. Rejection of Claim 9 Under 35 U.S.C. §103(a)**

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Cseri *et al.* in view of Houben *et al.* (US 2002/0147745). Withdrawal of this rejection is requested for at least the following reasons. Claim 9 depends from independent claim 1 and Houben *et al.* fails to cure the aforementioned deficiencies of Cseri *et al.* with respect to independent claim 1. Accordingly, reversal of this rejection is requested.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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